

REMARKS

Favorable reconsideration of this application in light of the following discussion is respectfully requested.

Claims 1-5, 12-14, 50, 52, 56, 57, 64, 65, 73, 74, 82, 84, 86, 88-91 and 102-135 are presently active in this case. The present Amendment adds Claims 118-135.

In the outstanding Office Action, Claims 1-5, 12-14, 50, 52, 73, 74, 82, 84, 86, 88-91 and 102-117 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Abo et al. (U.S. Patent No. 5,948,041) in view of Ishida et al. (U.S. Patent No. 5,613,202).

However, Claims 56, 57, 64 and 65 were allowed. Applicant acknowledges with appreciation the indication of allowable subject matter.

Applicant respectfully traverse the rejection of Claims 1-5, 12-14, 50, 52, 73, 74, 82, 84, 86, 88-91 and 102-117

In response to the rejection of Claims 1-5, 12-14, 50, 52, 73, 74, 82, 84, 86, 88-91 and 102-117 under 35 U.S.C. §103(a), Applicant respectfully requests reconsideration of this rejection and traverses the rejection as discussed next.

The rejected claims are directed to information processing apparatus and methods of processing information. Independent Claims 1, 4, 5, 12, 73, 82, 84, 86, 88, 90 recite the feature of capturing information including at least time information.

Turning to the applied prior art, the Abo et al. patent discloses a device for displaying the location of a vehicle. The device calculates the "coordinates of a present position for the vehicle based on signals from a GPS (Global Position System) sensor, a gyro, a vehicle speed sensor and the like."¹ The coordinates of the present location are stored and compared to location data to compute distances between the present location and the location of area

¹ The Abo et al. patent at column 3, lines 40-45.

centers.² The device can display current weather information received from the area center closest to the present location. The Abo et al. patent, however, fails to disclose means/input for, or a step of, capturing information, *including at least time information*, as recited in Applicant's independent Claims 1, 4, 5, 12, 73, 82, 84, 86, 88 and 90. As acknowledged by the outstanding Office Action, the Abo et al. patent "fails to disclose time information."³

The outstanding Office Action turns to the Ishida et al. patent for the feature of capturing time information. The Ishida et al. patent discloses a mobile telephone system, in which the user has the option of creating a memorandum stored with a current time.⁴ The memorandum can be displayed on the telephone afterward.⁵ The outstanding Office Action states that "it would have been obvious ... to add such a feature to Abo, as it would allow a brief memorandum to be added with the captured information as suggested by Ishida, an advantage over the invention of Abo."⁶ Applicant respectfully traverses this statement because there is insufficient evidence of record for the required motivation to modify the Abo et al. device by incorporating Ishida et al.'s memorandum feature, for the following reasons.⁷

While the Ishida et al. patent may provide a reason for incorporating a memorandum feature in its mobile telephone system, the Ishida et al. patent fails to suggest why a person of

² The Abo et al. patent at column 3, lines 59-67.

³ Outstanding Office Action at page 2, last line.

⁴ The Ishida et al. patent at column 4, lines 40-55.

⁵ The Ishida et al. patent at column 4, lines 55-59.

⁶ See outstanding Office Action at page 3, lines 3-5.

⁷ See MPEP 2143.01 stating "[o]bviousness can only be established by combining or modifying the teaching of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art," (citations omitted). See also MPEP 2144.08 III stating that "[e]xplicit findings on motivation or suggestion to select the claimed invention should also be articulated in order to support a 35 U.S.C. 103 ground of rejection. . . Conclusory statements of similarity or motivation, without any articulated rational or evidentiary support, do not constitute sufficient factual findings."

ordinary skill in the art would be motivated to incorporate such a feature in a device for displaying the location of a vehicle such as the one disclosed in the Abo et al. patent.

Furthermore, the Abo et al. patent states that the Abo et al. system already achieves Abo et al.'s goal of displaying current location to a vehicle driver.⁸ The Abo et al. patent does not suggest that an additional feature is needed to achieve its intended goal. In particular, the Abo et al. patent does not suggest that a memorandum feature, such as the one disclosed in the Ishida et al. patent, would be desired. On the contrary, the Abo et al. patent stresses the importance of reducing the number of tasks performed by the user so that the "driver of a vehicle can obtain needed information without turning attention away from driving."⁹ The Abo et al. patent thus teaches away from adding a feature that increases user input. The memorandum feature requires more input from the user because it requires the user to input characters through the keypad to compose the memorandum.¹⁰ Therefore, a person of ordinary skill in the art would not be motivated to add a feature to the Abo et al. system that increases user input, such as the memorandum feature disclosed in the Ishida et al. patent.¹¹

The Abo et al. and Ishida et al. patents, therefore, do not provide the motivation to perform the proposed modification of the Abo et al. device. In other words, an attempt to bring in the isolated teaching of Ishida et al.'s memorandum feature into the Abo et al. device would amount to improperly picking and choosing features from different references without regard to the teachings of the references as a whole.¹² While the required evidence of

⁸ See the Abo et al. patent, for example, at column 4, lines 5-19.

⁹ The Abo et al. patent at column 1, lines 37-40 and at column 2, lines 4-5.

¹⁰ The Ishida et al. patent at column 4, lines 32-41.

¹¹ See MPEP 2141.02 stating "[a] prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention" (emphasis in original) (citations omitted).

¹² See In re Ehrreich 590 F2d 902, 200 USPQ 504 (CCPA, 1979) (stating that patentability must be addressed "in terms of what would have been obvious to one of ordinary skill in the art at the time the invention was made in view of the sum of all the relevant teachings in the

motivation to combine need not come from the applied references themselves, the evidence must come from *somewhere* within the record. In this case, there is nothing in the record supporting the Office Action's proposed modification of the Abo et al. patent.

In rejecting a claim under 35 U.S.C. § 103(a), the USPTO must support its rejection by "substantial evidence" within the record,¹³ and by "clear and particular" evidence¹⁴ of a suggestion, teaching, or motivation to combine the teachings of different references. As discussed above, there is no substantial evidence, nor clear and particular evidence, within the record of motivation for modifying the Abo et al. device by incorporating Ishida et al.'s memorandum feature. Without such motivation and absent improper hindsight reconstruction,¹⁵ a person of ordinary skill in the art would not be motivated to perform the proposed modification, and Claims 1-5, 12-14, 50, 52, 73, 74, 82, 84, 86, 88-91 and 102-117 are believed to be non-obvious and patentable over the applied prior art.

art, not in view of first one and then another of the isolated teachings in the art," and that one "must consider the entirety of the disclosure made by the references, and avoid combining them indiscriminately.")

¹³ In re Gartside, 203 F3d 1305, 53 USPQ2d 1769 (Fed. Cir. 2000) (holding that, consistent with the Administrative Procedure Act at 5 USC 706(e), the CAFC reviews the Board's decisions based on factfindings, such as 35 U.S.C. § 103(a) rejections, using the 'substantial evidence' standard because these decisions are confined to the factual record compiled by the Board.)

¹⁴ In re Dembiczak, 175 F3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("We have noted that evidence of a suggestion, teaching, or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, although 'the suggestion more often comes from the teachings of the pertinent references.' The range of sources available, however, does not diminish the requirement for actual evidence. That is, the showing must be clear and particular." (emphasis added).

¹⁵ See MPEP 2141, stating, as one of the tenets of patent law applying to 35 USC 103, that "[t]he references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention."

Applicants respectfully traverse the rejection of Claims 2 and 13

Applicant further respectfully requests reconsideration of the rejection of Claim 2 (and presumably Claim 13)¹⁶ because the outstanding Office Action fails to identify any prior art document teaching or suggesting the claimed combination of features. Specifically, the outstanding Office Action admits that the Abo et al. patent "fails to disclose that the transmitted information is captured information, that is, that the acquired data is received in response to the transmission of captured data."¹⁷ The outstanding Office Action then identifies an advantage of the claimed invention: reducing "the amount of acquired data needed to be sent."¹⁸ The outstanding Office Action, however, fails to identify any prior art document teaching or suggesting that transmitting the captured information reduces the amount of acquired data needed to be sent. The only document of record teaching the claimed combination of features is Applicant's own disclosure. Therefore, the outstanding rejection of Claim 2 (and presumably Claim 13) appears to be the product of improper hindsight reconstruction and is thus respectfully traversed.¹⁹

Applicants respectfully traverse the rejection of Claims 103-107, 109-113

Applicant further respectfully requests reconsideration of the rejection of Claims 103-107, 109-113 because the prior art does not teach or suggest capturing or storing music information. The Abo et al. and Ishida et al. patents do not refer to, and are not concerned with, music information. The Abo et al. and Ishida et al. systems are not intended to, nor

¹⁶ The outstanding Office Action does not explain the ground for rejecting Claim 13. Applicant assumes that Claim 13 was rejected on similar ground as presented for Claim 2.

¹⁷ Outstanding Office Action at page 3, lines 8-10.

¹⁸ Outstanding Office Action at page 3, lines 12-13.

¹⁹ See MPEP 2141, stating, as one of the tenets of patent law applying to 35 USC 103, that "[t]he references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention."

configured to, capture or store music information. Nothing in the Abo et al. and Ishida et al. patents suggests capturing or storing music information.

The outstanding Office Action states that “since Abo in view of Ishida discloses a memory, which *may be used* to store any data, such *would inherently* include music and other kinds of data.”²⁰ However, Applicant respectfully traverses this statement because the doctrine of inherency does not apply in this case. The fact that the Abo et al./Ishida et al. memory “may be used” to store music does not establish that the memory inherently stores music. This is because capturing and storing music does not “necessarily flow from” the capability of storing data.²¹ Furthermore, even assuming that the Abo et al./Ishida et al. memory was *capable of* storing music, this would be insufficient to establish a prima facie case of obviousness.²² Nothing in Abo et al. and Ishida et al. patents teaches or suggests, either explicitly or inherently, capturing and storing music, and thus the rejection of Claims 103-107, 109-113 is respectfully traversed.²³

New claims 118-125 recite a recording device configured to record information related to a music playing when the recording device records said information. New Claims 126-135 recite that the time information corresponds to a time when a music is playing. New Claims 126-132 further recite that the information acquired relates to this music. These

²⁰ Outstanding Office Action at page 4, lines 2-3 from the bottom (emphasis added).

²¹ See MPEP 2112: “In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” (Citing Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).

²² See MPEP 2143.01 stating that “[a]lthough a prior art device ‘may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so,’” (citation omitted).

²³ Applicant further traverses the outstanding rejections of Claims 4, 5, 73, 114-117, based on the theory of inherency because the outstanding Office Action fails to provide “a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.”

features find support in the disclosure as originally filed and are thus not believed to raise a question of new matter. At least for the same reasons just mentioned with respect to Claims 103-107, 109-113, Applicant respectfully submits that Claims 118-135 are patentably distinct over the prior art.

Consequently, in view of the present amendment, no further issues are believed to be outstanding in the present application, and the present application is believed to be in condition for formal Allowance. A Notice of Allowance for Claims 1-5, 12-14, 50, 52, 56, 57, 64, 65, 73, 74, 82, 84, 86, 88-91 and 102-135 is earnestly solicited.

Should the Examiner deem that any further action is necessary to place this application in even better form for allowance, the Examiner is encouraged to contact Applicant's undersigned representative at the below listed telephone number.

Respectfully submitted,

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